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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/298,523	04/23/99	BRILES	D 454312-3140

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EXAMINER

MINNIFIELD, N

ART UNIT

PAPER NUMBER

1645

13

DATE MAILED:

05/23/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.  
09/298,523

Applicant(s)

BRILES ET AL

Examiner  
N. M. Minnifield

Art Unit  
1645



-- The MAILING DATE of this communication appears in the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1) ☒ Responsive to communication(s) filed on Dec 19, 2000

2a) ☐ This action is FINAL.

2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1035 C.D. 11; 453 O.G. 213.

## Disposition of Claims

4) ☒ Claim(s) 1-27 is/are pending in the application

4a) Of the above, claim(s) 4-27 is/are withdrawn from consideration

5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.

6) ☒ Claim(s) 1-3 is/are rejected.

7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.

8) ☒ Claims 4-27 are subject to restriction and/or election requirements

## Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.

12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a) ☐ All b) ☐ Some\* c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.

2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_

3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

15) ☒ Notice of References Cited (PTO-892) 4 sheets

16) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)

17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5

18) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_

19) ☐ Notice of Informal Patent Application (PTO-152)

20) ☐ Other: \_\_\_\_\_

Art Unit: 1645

#### DETAILED ACTION

1. Applicant's election of Group I, claims 1-3 and species PspC, in Paper No. 9 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).
2. Claims 4-27 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected inventions and species, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 9.
3. Claims 1-3 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims are vague and indefinite because it contains the use of an alternative expression (and/or) wherein the limitation covers two different elements. See MPEP 706.03(d), paragraph 5. The claims are vague and indefinite in the recitation of epitope or epitopic region of PspC; where are these regions within the PspC? Have they been defined by specific amino acid sequences? What specific portion of the proline-rich region is considered the epitope of epitopic region of PspC?

Art Unit: 1645

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-3 are rejected under 35 U.S.C. 102(a or b) as being anticipated by Brooks-Walter (ASM 1997 abstract), Briles et al (1997 Microbial Drug Resistance; review presented in 1996) or Swiatlo et al (1997).

The claims are directed to an isolated polypeptide comprising at least on epitope or epitopic region of PspC. It is noted that specification defines the epitope or epitopic region of PspC to be the proline rich region (see p. 35; p. 7) or the alpha helical region (see p. 7).

Brooks-Walter disclose a PspC protein that is highly antigenic, and that has a proline rich region and alpha helical region.

Briles et al disclose a PspC protein that has an N-terminal alpha helical domain, a proline-rich domain (p. 406, cols. 1 and 2).

Art Unit: 1645

Swiatlo et al discloses an isolated protein having a proline-rich region and alpha-helical coding domain (abstract). It is noted that the "pspA-like" protein is now called PspC.

The prior art discloses the claimed isolated polypeptide. Since the Office does not have the facilities for examining and comparing applicants' polypeptide with the polypeptide of the prior art, the burden is on applicant to show a novel or unobvious difference between the claimed product and the product of the prior art (i.e., that the polypeptide of the prior art does not possess the same material structural and functional characteristics of the claimed polypeptide). See In re Best, 562 F.2d 1252, 195 USPQ 430 (CCPA 1977) and In re Fitzgerald et al., 205 USPQ 594.

7. No claims are allowed.

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to N. M. Minnifield whose telephone number is (703) 305-3394. The examiner can normally be reached on Monday-Thursday from 7:00 AM-4:30 PM. The examiner can also be reached on alternate Fridays.

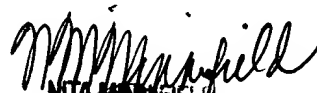
Art Unit: 1645

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lynette R. F. Smith, can be reached on (703) 308-3909. The fax phone number for Technology Center 1600 is (703) 308-4556.

Any inquiry of a general nature or relating to the status of this application should be directed to the Technology Center 1600 receptionist whose telephone number is (703) 308-0196.

N. M. Minnifield

May 21, 2001

  
NITA MINNIFIELD  
PRIMARY EXAMINER